

REMARKS

Claims 1-10 and 12-16 are pending. Claims 11 and 17 have been canceled. Claims 1, 6, 7 and 15 have been amended. Claims 6, 7 and 15 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. Claims 1, 10, 12-14 and 16 have been rejected under 35 U.S.C. §102(b) as being anticipated by JP 11040846 A ("Hisanaga et al."). Claims 2-5, 8 and 9 have been allowed. Claims 6, 7, and 15 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112.

Allowable Subject Matter

Applicants gratefully acknowledge the indication by the Examiner that claims 2-4, 5, 8 and 9 are allowable, and claims 6, 7 and 15 (claim 15 depending from claim 7) would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112. Claims 6, 7 and 15 have been amended as described in the following section. These amendments are made solely to expedite prosecution, and do not represent acquiescence by Applicants to any rejections.

Claim Rejections – 35 USC §112

Claim 6 has been rejected under 35 USC §112, second paragraph, as elements "a first electrode," "a p-type gallium nitride layer," and "a second electrode layer," are introduced twice, first by incorporation of claim 5 by reference, then literally. Claim 6 has been amended to delete the dependency from claim 5.

Accordingly, Applicants respectfully request reconsideration of this rejection and an indication of allowance.

Claim 7 has been rejected as "the third electrode layer" has no antecedent basis. Claim 7 has been amended to change its dependency from claim 5 to claim 6. Applicants submit that the antecedent basis for "the third electrode layer" in claim 7 is found in claim 6. Accordingly, Applicants respectfully request reconsideration of this rejection and an indication of allowance.

Claim 15 has been amended to match the range identified in the written description. Specifically, not necessary amended claim 15 recites "The thin film electrode according to claim 7, wherein... overall thickness of 1 ~ **50,000 Å**." Support for the amended term "50,000 Å" is found in the specification, page 8, line 23. Claim 15 has been rejected due to its dependency from the rejected claim 7. As mentioned above, claim 7 has been amended to address the rejection for the missing antecedent basis. As such, Applicants believe the amended claim 15 is now allowable, and respectfully request reconsideration of this rejection and an indication of allowance.

Claim Rejections – 35 USC §102

Claims 1 and 16 have been rejected under 35 U.S.C. §102(b) as being anticipated by JP 11040846 A ("Hisanaga et al."). Claim 1 has been amended to recite:

1. A thin film electrode for... and a second electrode layer... including at least one element selected from the group consisting of Pd, Ni, Ru, Rh, Re, C, Cu and Ir.

To anticipate a claim, the cited reference must teach every element of the claim. MPEP §2131. Hisanaga et al. teaches electrode layers 12, 13 that are laminated on the first electrode layer 11 and made of Pt and Au, respectively. Thus, Hisanaga et al. fails to teach **“a second electrode layer... including at least one element selected from the group consisting of Pd, Ni, Ru, Rh, Re, C, Cu and Ir.”** as recited in amended independent claim 1. Accordingly, claim 1 is not anticipated by Hisanaga et al. Applicants submit that claim 1 is now allowable over Hisanaga et al.

Claim 16 depends from independent claim 1, and is patentable for at least the same reasons. Accordingly, Applicants request that the rejection to claims 1 and 16 be withdrawn and that an indication of allowance be issued.

Claims 10 and 12-14 have been rejected under 35 U.S.C. §102(b) as being anticipated by JP 11040846 A ("Hisanaga et al."). This rejection is respectfully traversed.

Claim 10 has been amended to correct a minor oversight. (A term **“layer”** has been added after “the first electrode”.) Hisanaga et al. teaches electrode layers 12, 13 laminated on the first electrode layer 11 and made of Pt and Au, respectively. Thus, Hisanaga et al. fails to teach **“a second electrode layer laminated on the first electrode layer... including at least one element selected from the group consisting of Al, Ag and Rh”** as recited in amended independent claim 10. Accordingly, claim 10 is not anticipated by Hisanaga et al. Applicants submit that claim 10 is now allowable over Hisanaga et al.

Claims 12- 14 depend from independent claim 10, and as such, are also patentable for at least the same reasons. Accordingly, Applicants request that the rejection to claims 10 and 12-14 be withdrawn and that an indication of allowance be issued.

Conclusion

Based on the reasons as set forth above, Applicants respectfully request allowance of all the pending claims, including claims 1-10 and 12-16.

In the event that there are any questions concerning this paper, or the application in general, the Examiner is respectfully urged to telephone Applicants' undersigned representative so that prosecution of the application may be expedited.

Respectfully submitted,

BUCHANAN INGERSOLL, L.L.P.

Date: September 6, 2005

By: 

Charles F. Wieland III
Registration No. 33,096

P.O. Box 1404
Alexandria, Virginia 22313-1404
(650) 622-2348